

REMARKS

Applicants submit this Reply to the final Office Action mailed January 10, 2008.

By this Reply, Applicants have amended the specification, amended claims 14, 29, 31, 32, 33, 35, 36, and 39, and canceled claims 28, 30, 37, and 38 without prejudice or disclaimer. Accordingly, claims 14-27, 29, 31-36, and 39 remain pending in this application, among which claim 14 is independent. The originally-filed application fully supports the subject matter of the amended specification and amendments to claims 14, 29, 31, 32, 35, 36 and 39. Thus, the Reply introduces no new matter.

In the Office Action, the Examiner took the following actions: (1) rejected claims 14-16 under 35 U.S.C. § 103(a) as being unpatentable over Ueda (U.S. Patent No. 6,122,009) ("Ueda") in view of Hajime Oge (JP Patent No. 409312808A) ("Oge"); (2) rejected claim 39 under 35 U.S.C. § 103(a) as being unpatentable over Ueda, Oge and in further view of Ikeda (U.S. Patent No. 5,783,815) ("Ikeda"); (3) rejected claims 17 and 21-27 under 35 U.S.C. § 103(a) as being unpatentable over Ueda in view of Oge; (4) rejected claims 18-20, 28, 30-37 under 35 U.S.C. § 103(a) as being unpatentable over Ueda, Oge and in further view of Toyoda et al. (U.S. Pub. No. 2001/0012073) ("Toyoda"); (5) rejected claims 29 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Ueda, Oge, Toyoda and in further view of Basista et al. (U.S. Patent No. 4,451,124) ("Basista").

Applicants respectfully traverse these rejections above and respectfully request reconsideration for at least the reasons provided below.

The Examiner asserts that claim 14 of the present application "does not recite 'a peripheral top surface formed around the photoelectrically converting section and not on

the base board' in order to overcome Ueda reference." See Office Action, p. 2.

(emphasis added). Applicants have amended claim 14 to more clearly recite the claimed subject matter of the present application. Applicants submit that claim 14 clearly recites that the "image pickup element" includes "a plate attached to mounted on the base board," and "a peripheral top surface formed on the top surface of the plate around the photoelectrically converting section." From the amended claim 14, the original and amended specification, and the original drawings (e.g., Figs. 1 and 5), it is clear that the "plate" included in the image pickup element is a separate body from the base board (PC), and is mounted on the base board. Therefore, the "peripheral top surface formed on the top surface of the plate around the photoelectrically converting section" is not on the base board. Accordingly, Ueda does not teach or suggest the claimed invention, including, for example, "a peripheral top surface formed on the top surface of the plate around the photoelectrically converting section" recited in amended claim 14.

Furthermore, the Examiner argues that the "peripheral top surface" in Ueda "is read as wherein the leg section of the lens rests and where terminals to connect the CCD 12 are located," and that "the leg of the lens section 54 rests on the substrate 51." According to this interpretation, the "peripheral top surface" in Ueda comprises two portions, a first portion being a surface of the substrate 51 (corresponding to the "base board" in claim 14) where the leg section of the lens rests, and a second portion being a surface of CCD 12 (corresponding to the "plate" in claim 14) where the terminals contact. Even according to this broad interpretation of the term "peripheral top surface" by the Examiner, which Applicants do not concede, the contact surface (of the leg) of

the optical member (i.e., the lens section 54) is in direct contact with the first portion of the “peripheral top surface,” that is, the portion on the substrate 51, but not the second portion of the “peripheral top surface,” that is, the portion on CCD 12. Therefore, Ueda does not teach or suggest the “contact surface of the optical member” being “in direct contact with the peripheral top surface,” which is “formed on the top surface of the plate” (corresponding to CCD 12 in Ueda) mounted on the base board (corresponding to substrate 51 in Ueda) (see amended claim 14). Therefore, Ueda fails to teach or suggest the claimed combination including, among other things:

“wherein the optical member is mounted on the image pickup element such that a position between the lens section and the photoelectrically converting section of the image pickup element in an optical axis direction is determined by bringing the contact surface of the optical member in direct contact with the peripheral top surface or with a top surface member when the top surface member is provided on the peripheral surface.”

(Amended claim 14, emphasis added).

Also, from the above analysis, it is clear that in Ueda, the leg of the lens section 54 rests on the substrate 51, not on the photoelectric section (CCD) 12. Figs. 5-6 of Ueda actually show that the lens section 54 is mounted through the leg resting on the substrate 51 by directly contacting the substrate 51 (Fig. 5), or by indirectly contacting the substrate 51 through a filler 20 (Fig. 6). Therefore, Applicants respectfully disagree with the Examiner’s contention that Ueda discloses “in figure 45, [when] the optical element including the lens section 54 is mounted on the photoelectric section 12.” Clearly, the optical element including the lens section 54 is mounted on the substrate 51 through the leg, but not on the photoelectric section (CCD) 12. Therefore, the way the optical element including the lens section 54 is mounted as disclosed in Ueda is

different from the structure disclosed in the present application, where "the optical member is mounted on the image pickup element" (corresponding to photoelectric section (CCD) 12 in Ueda) through "[a] contact surface of the optical member" being "in direct contact with the peripheral top surface or with a top surface member when the top surface member is provided on the peripheral surface." See amended claim 14, and please note that the "peripheral top surface" is "formed on the top surface of the plate" (corresponding to photoelectric section (CCD) 12 in Ueda) mounted on the base board (corresponding to substrate 51 in Ueda).

Therefore, Ueda fails to teach the claimed structure including, for example, that "the optical member is mounted on the image pickup element such that a position between the lens section and the photoelectrically converting section of the image pickup element in an optical axis direction is determined by bringing the contact surface of the optical member in direct contact with the peripheral top surface or with a top surface member when the top surface member is provided on the peripheral surface," as recited in claim 14.

Furthermore, as admitted by the Examiner, Ueda fails to teach "a lens frame having a slidable contact surface at a lower end thereof and an inner space in which the optical member is accommodated so as to come in contact with an inner wall of the lens frame." (claim 14, emphasis added). Accordingly, in order to cure the deficiencies of Ueda, the Examiner relies on Oge for its asserted disclosure of "a lens structure 3 as shown in figure 4 that is moved in the X-Y direction to the CCD chip 2 on a substrate 1 (see figures 1-5) it adjusts [sic] so that a mark 5 may be arranged for alignment with the

help of pattern detectors 9a and 9b, so that the axis of CCD chip and lens 6 will come in alignment (Paragraph 12)." (Office Action, p. 5).

Although Oge may have disclosed a lens frame having a slidable contact surface, Oge does not cure the deficiencies of Ueda. Applicants note that in Oge, the lens structure 3 is mounted on the substrate 1 through legs 3a contacting a surface of the substrate 1. Therefore, lens structure 3 is not mounted on the CCD chip 2, as clearly shown in Fig. 4 of Oge. Therefore, Oge fails to teach the structure that "the optical member is mounted on the image pickup element such that a position between the lens section and the photoelectrically converting section of the image pickup element in an optical axis direction is determined by bringing the contact surface of the optical member in direct contact with the peripheral top surface or with a top surface member when the top surface member is provided on the peripheral surface," as recited in claim 14. (emphasis added). Please note that the "peripheral top surface" in claim 14 is "formed on the top surface of the plate" (corresponding to CCD chip 2 in Oge) mounted on the base board (corresponding to substrate 1 in Oge).

Therefore, since Ueda and Oge, taken alone or in combination, fail to teach the claimed structure, including any image pickup device where "the optical member is mounted on the image pickup element such that a position between the lens section and the photoelectrically converting section of the image pickup element in an optical axis direction is determined by bringing the contact surface of the optical member in direct contact with the peripheral top surface or with a top surface member when the top surface member is provided on the peripheral surface," the structure recited in claim 14

would not have been obtained. Consequently, the present invention recited in claim 14 would not have been obvious over Ueda and Oge at the time the invention was made.

Therefore, Applicants respectfully traverse the Examiner's rejection of independent claim 14, and request withdrawal of the rejection of claim 14. Claims 15-16 should also be allowable at least by virtue of their dependencies from the base claim 14.

Claim 39 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ueda, Oge, and further in view of Ikeda. Applicants respectfully traverse the Examiner's rejection of claim 39. Even if Ikeda teaches what the Examiner alleges (and Applicants do not necessarily agree that it does), Ikeda fails to overcome the above-described deficiencies of Ueda and Oge. Accordingly, claim 39 is allowable at least by virtue of its dependence from base claim 14. Applicants therefore request the Examiner to withdraw the rejection of claim 39 under 35 U.S.C. § 103(a).

Claims 17 and 21-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ueda in view of Oge. Applicants respectfully traverse the Examiner's rejection of claims 17 and 21-27. Claims 17 and 21-27 should be allowable at least by virtue of their dependencies from base claim 14. Applicants therefore request the rejection of claims 17 and 21-27 under 35 U.S.C. § 103(a) be withdrawn.

Claims 18-20, 28, and 30-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ueda, Oge, and further in view of Toyoda. By this Amendment, claims 28, 30, and 37 are canceled, therefore, the rejection of claims 28, 30 and 37 under 35 U.S.C. § 103(a) is moot. With regard to claims 18-20 and 31-36, Applicants submit that even if Toyoda teaches what the Examiner alleges (and Applicants do not

necessarily agree that it does), Toyoda fails to overcome the above-described deficiencies of Ueda and Oge. Therefore, claims 18-20 and 31-36 should be allowable at least by virtue of their dependencies from base claim 14, respectively. Applicants therefore respectfully request that the rejection of claims 18-20 and 31-36 under 35 U.S.C. § 103(a) be withdrawn.

Claims 29 and 38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ueda, Oge, Toyoda, and further in view of Basista. By this Amendment, claim 38 is canceled, therefore rejection of claim 38 under 35 U.S.C. § 103(a) is moot. With regard to claim 29, Applicants submit that even if Basista teaches what the Examiner alleges (and Applicants do not necessarily agree that it does), Basista fails to overcome the above-described deficiencies of Ueda, Oge, and Toyoda. Therefore, claim 29 should be allowable at least by virtue of its dependence from base claim 14. Applicants therefore respectfully request that the rejection of claim 29 under 35 U.S.C. § 103(a) be withdrawn.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 14-27, 29, 31-36, and 39 in condition for allowance. Applicants submit that the proposed amendments of claims 14, 29, 31, 32, 35, 36 and 39 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

PATENT

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Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is not rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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